

REMARKS

In response to the final Office Action dated 24 December 2003, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-23 are pending in the application, and are rejected. Claims 1, 8, 12, 13, and 21 will be amended, and new claims 26 and 27 will be added, upon entry of the present amendment.

Telephone Interview

The applicant thanks Examiner Lee for the telephone interview granted on Monday, 15 March 2004, between himself and the applicant's representative Mr. Mates (Reg. No. 35,271). The final Office Action dated 24 December 2003 and the applicant's position set forth below were discussed, and no agreement was reached.

Claim Amendments

Independent claims 1, 12, and 21 will be amended upon entry of the present amendment to recite the direction of power flows as was discussed in the above-referenced interview.

New Claims

New claims 26 and 27 are added containing the features in original claims 24 and 25 that were canceled. New claims 26 and 27 are added in view of the amendment to claim 21.

Rejections of Claims Under §103

Claims 1-4, 7, 8 and 11 were rejected under 35 USC § 103(a) as being unpatentable over Yaguchi et al. (JP 2000-232969 A, Yaguchi) in view of Tsai (U.S. 6,283,789). The applicant respectfully traverses.

The MPEP states the following with regard to rejections under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art. MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

The applicant respectfully submits that there is no evidence of a suggestion or motivation to combine Yaguchi and Tsai.

Yaguchi relates to a USB hub, and as the Office Action states, Yaguchi “does not expressly teach a downstream receptacle connected to both said power supply and said bus hub.” Final Office Action, page 2. Tsai relates to a “data and power transmitting cable system” conforming to the USB standard. Tsai, Abstract. Tsai describes the cable system in column 3, lines 51-63, as connecting a first pair of ports 110,210 “for transmission of power and data.” A second pair of ports 120,210 is connected “solely for transmission of additional power.” The advantage of Tsai is that:

“a supplementary power circuit is formed between the second port 120 and one of the ports 210 for delivering extra power to the peripheral device port system 100, without any need of an extra power supply.” Tsai, col 3, ln 59-64.

The USB hub of Yaguchi is described as having its own power supply 15. Yaguchi describes in paragraph [0012] that the power supply 15 provides power to the USB port 12 and the USB cable 14. One skilled in the art would not have been motivated to replace the cable 14 of Yaguchi with the cable system of Tsai because the USB hub of Yaguchi has its own power supply 15 and does not need the additional power transmitted by the cable system of Tsai. Yaguchi already has the “extra power supply” that is not needed in Tsai. Thus, there is no evidence of a suggestion or motivation to combine Yaguchi and Tsai.

The final Office Action states that system 100 of Figure 18 and col. 3, lines 51-56 of Tsai “implies that said downstream receptacle connected to both a power supply and a bus hub.” Final Office Action, page 2. The applicant does not agree that Tsai “implies” such a connection. Tsai only describes the cable conforming to the USB standard, and does not show or suggest any connections outside the cable.

The applicant respectfully submits that the final Office Action has not established a *prima facie* case of obviousness of claims 1-4, 7, 8 and 11, and that claims 1-4, 7, 8 and 11 are in condition for allowance.

Claims 5 and 6 were rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Tsai and Urade et al. (U.S. Patent No. 6,272,644, Urade). Claim 9 was rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Tsai and Decuir (U.S. Patent No. 5,781,028). Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Tsai and Sanchez (U.S. Patent No. 6,446,867). Claims 12, 13, 16, 17 and 19 were rejected under 35 USC § 103(a) as being unpatentable over Shimazaki (U.S. Patent No. 6,338,143) in view of Yaguchi and Tsai. Claim 14 was rejected under 35 USC § 103(a) as being unpatentable over Shimazaki in view of Yaguchi, Tsai, and Decuir. Claim 15 was rejected under 35 USC § 103(a) as being unpatentable over Shimazaki in view of Yaguchi, Tsai, and Sanchez. Claims 18 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Shimazaki in view of Yaguchi, Tsai, and Urade. The applicant respectfully traverses.

The applicant respectfully submits that there is no evidence of a suggestion or motivation to combine Yaguchi and Tsai for the reasons stated above with respect to the rejection of claims 1-4, 7, 8 and 11. The rejections of claims 5, 6, 9, 10, and 12-20 do not supply such a motivation. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 5, 6, 9, 10, and 12-20, and that claims 5, 6, 9, 10, and 12-20 are in condition for allowance.

Claims 21-23 were rejected under 35 USC § 103(a) as being unpatentable over Tsai in view of Linnell (U.S. 6,466,718). The applicant respectfully traverses.

Amended claim 21 recites a cable comprising a device power wire to provide power from a computer to a power hub, a device ground wire, a computer power wire to provide power from the power hub to the computer, a computer ground wire and a plurality of signal wires to carry data signals between the computer and the power hub.

Tsai relates to a “data and power transmitting cable system” conforming to the USB standard. Tsai, Abstract. Tsai describes the cable system in column 3, lines 51-63, as connecting a first pair of ports 110,210 “for transmission of power and data.” A second pair of ports 120,210 is connected “solely for transmission of additional power.” Power in the cable system of Tsai goes in the same direction in both connections. Tsai does not show a device power wire to provide power from a computer to a power hub and a computer power wire to provide power from the power hub to the computer as recited in amended claim 21. Linnell does not supply the elements missing in Tsai.

The applicant respectfully submits that the combination of Tsai and Linnell does not show or suggest all of the features recited in amended claim 21, and that amended claim 21 is in condition for allowance. Claims 22 and 23 depend on amended claim 21, and recite further features with respect to amended claim 21. For reasons analogous to those stated above, and the features in the claims, the applicant respectfully submits that Tsai and Linnell do not show or suggest all of the features recited in claims 22-23, and that claims 22-23 are in condition for allowance.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/730238

Filing Date: December 5, 2000

Title: POWER SUPPLY WITH BUS HUB

Assignee: Intel Corporation

Page 10

Dkt: 884.335US1 (INTEL)

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the Applicant's attorney, Robert Mates at 612-373-6973, or Applicant's below-signed attorney at 612-373-6970 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

BRIAN A. LEETE

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

Attorneys for Intel Corporation

P.O. Box 2938

Minneapolis, Minnesota 55402

(612) 373-6970

Date

March 24, 2004

By

Charles E. Steffey

Charles E. Steffey
Reg. No. 25,179

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of March 2004.

Anne M. Richards

Name

Anne M. Richards

Signature